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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,236	04/13/2000	KEVIN W. CARLEY	AND1P405	7816

29838 7590 06/18/2003

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EXAMINER

MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/549,236

Applicant(s)

CARLEY ET AL.

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. In the amendment filed 3/24/03 in paper number 9, the following has occurred: Claims 19-33 has been added. Now claims 1-33 are presented for examination.

Information Disclosure Statement

2. The Information Disclosure Statement filed 10/28/02 has been received and entered.

Specification

3. The amendment filed 3/24/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The newly added recitation of a multi-tier client/server architecture that maintains a connection between multiple user stations and a server having a database; receiving from one of the user stations a plurality of user input data files; receiving a plurality of user-selected keywords, wherein data contained within said user input data files is organized around the keywords; and selecting a data management template corresponding to the keywords within claims 19, 24, and 29 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find, any support for a multi-tier client/server architecture receiving "user-selected keywords" wherein data contained within said user input data files is organized around the keywords within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

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Applicant is required to cancel the new matter in the reply to this Office action.

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. § 112, first paragraph, because the specification, as originally filed, does not provide support for the invention as is now claimed for the reasons given in section 3 above.

Claim Rejections - 35 USC § 112

6. Claims 19-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification above.

Independent claims 19, 24, and 29 recite limitations that are new matter, as discussed above.

Claims 20-23, 25-28, and 30-33 incorporate the deficiencies of independent claims 19, 24, and 29, through dependency, and are also rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 5, 7, 9-11, 13, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,267,155 to Buchanan et al. in view of U.S. Patent No. 5,410,551 to Edwards et al., for the same reasons given in the previous Office Action (paper number 6).

9. Claims 2, 4, 6, 8, 10, 12, 14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,267,155 to Buchanan et al. in view of U.S. Patent No. 5,410,551 to Edwards et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,469,576 to Dauerer et al., for the same reasons given in the previous Office Action (paper number 6).

10. Claims 19, 21, 24, 26, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,267,155 to Buchanan et al. and U.S. Patent No. 5,410,551 to Edwards et al. in view of U.S. Patent No. 6,523,022 to Hobbs.

As per claim 19, Buchanan et al. teach a computer-assisted document generation system including a relational database (2, Fig. 1) (reads on "data loaded into a database") used to manage document templates as well as storing, retrieving and manipulating data within the templates (see: column 5, lines 39-50). Buchanan et al. further teaches that the templates are

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created and selected by the user (reads on “selecting a data management template”) according to the type of report needed to accommodate a task (see: column 5, lines 5, 13-17). In addition, Buchanan teaches a document generation system using relational databases that are implemented using a B-tree model and the database manipulation is preformed through program calls to executable functions provided to a program (column 5, lines 52-57).

Buchanan et al. fail to teach a multi-tier client/server architecture, comprising the steps of:

- (a) maintaining a connection between multiple user stations and a server having a database;
- (b) receiving from one of the user stations a plurality of user input data files;
- (c) receiving a plurality of user-selected keywords, wherein data contained within said user input data files is organized around the keywords;
- (d) selecting a data management template corresponding to the keywords;
- (e) validating that all data to be loaded into the database match the data management template;
- (f) loading the validated data into the database; and,
- (g) compiling a report identifying data that match the data management template and data that do not match the data management template.

Edwards et al. teaches a network verification system including a comparing unit (180, Fig. 1) that detects mismatches between two lists of data items, first list (160, Fig. 1) and a second list (170, Fig. 1), also indicating any data item in the first list (160, Fig. 1) which do not having matching data item in the second list (170, Fig. 1) or vice versa and then records them in

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an error report (190, Fig. 1) (see: column 26, lines 38-56) (reads on “validating that all data to be loaded into the database match the data management template; loading the validated data into the database; and, compiling a report identifying data that match the data management template and data that do not match the data management template”). The Examiner considers the step of comparing data to included verifying the matched and unmatched data before it is compiled to generated an error report (reads on “generating error and summary reports for a data load”).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the validation of the loaded data as well as the compiling and generating of an error report as taught by Edwards within the computer-assisted document template system with a relational database as taught by Buchanan et al. with the motivation of detecting and preparing a summary report of matched and unmatched data in a database which better informs the user of any discrepancy involved with data being stored in the database.

Buchanan et al. and Edwards fail to teach a multi-tier client/server architecture, comprising the steps of:

- (a) maintaining a connection between multiple user stations and a server having a database;
- (b) receiving from one of the user stations a plurality of user input data files;
- (c) receiving a plurality of user-selected keywords, wherein data contained within said user input data files is organized around the keywords; and
- (d) selecting a data management template corresponding to the keywords.

Hobbs teaches a multi-tier client/server model (reads on “a multi-tier client/server architecture”) for record retrieval from a database based on embedded expert judgments linked to

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words, phrases, sentences and paragraphs of text entered by the user (reads on “receiving a plurality of user-selected keywords, wherein data contained within said user input data files is organized around the keywords”) (see: column 1, lines 20-42). Hobbs further teaches a client/server system includes a user remoter PC client (200, Fig. 3) connected to front-end communication servers (210, Fig. 3) that run and feed application queries through a database interface (200, Fig. 3) to the designated Data Warehouse (230, Fig. 3) (see: column 14, lines 42 to column 15, lines 27). Furthermore, Hobbs teaches that a client (203, Fig. 4), coupled to the Document Server (202, Fig. 4), including a browser that establishes a connection with the remoter servers (reads on “maintaining a connection between multiple user stations and a server having a database”) (see: column 15, lines 29-35). In addition, the client (203, Fig. 4) sends requests for information (client requests) to and receives information from the document server (202, Fig. 4) (reads on “receiving from one of the user stations a plurality of user input data files”) (see: column 15, lines 29-42).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the multi-tier client/server model for record retrieval from a database using linked words, phrases, sentences and paragraphs of text as taught by Hobbs with system as by Buchanan et al. and Edwards with the motivation of connecting “linked terms” to database records or templates, thereby saving enormous labor and time cost involved in updating a database (see: Hobbs: column 6, lines 55-61).

As per claim 21, Buchanan et al. teaches the claimed user input data files are medical files (see: column 7, lines 37-45 and Fig. 1).

Claim 24 differs from method claim 19 by reciting a “system for generating... “ in the preamble and recitation of logic in the body of the claim. As per this limitation, Buchanan et al. teaches a document generation system using a relational database that are implemented using B-tree model and the database manipulation is performed through program calls to executable functions provided by a program (see: column 5, lines 52-57). The remainder of claim 24 repeats the limitations of claim 19, and is therefore rejected for the same reasons given above for claim 19.

As per claims 26 and 31, they are rejected for the same reasons set forth in claim 21.

Claim 29 differs from method claim 19 by reciting a “a computer program embodied on the computer readable medium...” in the preamble and recitation of code segments in the body of the claim. As per this limitation, Buchanan et al. teaches a computer-assisted system that includes and electronic display (14, Fig. 1), data-processing device (16, Fig. 1) and electronic storage device (20, Fig. 1) used for storing information within a relational database (2, Fig. 1) (see: column 4, lines 14-26). The remainder of claim 29 repeats the limitations of claim 19, and is therefore rejected for the same reasons given above for claim 19.

11. Claims 20, 22-23, 25, 27-28, 30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,267,155 to Buchanan et al., U.S. Patent No. 5,410,551 to Edwards et al., U.S. Patent No. 6,523,022 to Hobbs as applied to claim 19 above, and further in view of U.S. Patent No. 5,410,576 to Dauerer et al.

As per claim 20, Buchanan et al., Edwards et al., and Hobbs teach a comparing unit (180, Fig. 1) that detects mismatches between all compared data as well as generating reports that include records of the matched and unmatched data (see: Edwards et al.: column 26, lines 38-56).

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In addition, Buchanan et al., Edwards et al., and Hobbs teach a relational database comprising a series of data structure linked through common fields and the data structures are used to store user responses during document creation (see: column 5, lines 39-52).

Buchanan et al., Edwards et al., and Hobbs fails to teach the claimed no data are loaded into the database if any of the data does not match the data management template.

Dauerer et al. teaches a data processing system that sorts and detected any mismatch data in addition to transmitting a plurality of reports to a remote user and these reports are distinguishable according to the mismatch data processed (see: column 14, lines 20-26). Since Dauerer et al. teaches denying access to the system once the detection of invalid or duplicate authorization occurs (see: column 4, lines 47-59). The Examiner considers denying of access once invalid or duplicate authorization occurs to include record invalidation that basically interrupts any further transmission of the records associated with the invalid or mismatched information and prevents the storing of the record into database.

One ordinary skill in the art at the time the invention was made would have found it obvious to include transmitting of reports including mismatch data as taught Dauerer et al. with the system as taught by Buchanan et al., Edwards et al., and Hobbs with the motivation of providing the user with several error report to ensure that inaccurate information is not being loading into the database.

As per claim 22, Buchanan et al., Edwards et al., Hobbs and Dauerer et al. teaches the claimed steps of separating data that match the data management template from data that do not match the data management template, and sending the data that do not match the data management template to the user station. This limitation is met by the comparing unit (180, Fig.

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1) that detects mismatches between all compared data as well as generating reports that include records of the matched and unmatched data (see: Edwards et al.: column 26, lines 38-56). In addition, Buchanan et al., Edwards et al., Hobbs and Dauerer et al. a data processing system that sorts and detected any mismatch data in addition to transmitting a plurality of reports to a remote user and these reports are distinguishable according to the mismatch data processed (see: Dauerer et al.: column 14, lines 20-26).

As per claim 23, Dauerer et al. teaches the claimed step of sending a notification upon detecting a concurrently executing load process. This feature is met by the data processing system that sorts and detected any mismatch data in addition to transmitting a plurality of reports to a remote user and these reports are distinguishable according to the mismatch data processed (see: Dauerer et al.: column 14, lines 20-26). The Examiner considers the transmission of reports to a remote user as notification to the user of the data that is matched and mismatched as well as the data that is entered and not entered into database.

As per claims 25 and 27-28, they are rejected for the same reasons set forth in claims 20 and 22-23, respectively.

As per claims 30 and 32-33, they are rejected for the same reasons set forth in claims 20 and 22-23, respectively.

Response to Arguments

12. Applicant's arguments filed 3/24/03 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 3/24/03.

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(A) In the remarks, Applicants argue in substance that, (1) Edward's reference is not analogous art; (2) a *prima facie* case of obviousness has not been supported by the examiner because there is no motivation to combine the reference of Buchanan and Edwards; and (3) a *prima facie* case of obviousness has not been supported by the Examiner in that all elements of claims 1, 7 and 13 are taught by the disclosed art.

(B) In response to Applicant's argument that, (1) Edward's reference is not analogous art. The Examiner respectfully submits it has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, although Edwards et al. is not in the medical records and data management field, it is clearly pertinent to the problem of detecting mismatches between two list of items, a first list (160, Fig. 1) and a second list (170, Fig. 1), also indicating any data item in the first list (160, Fig. 1) which do not have matching item in the second list (170, Fig. 1) or vice versa and then records them in an error report (190, Fig. 1) (see: Edwards: column 26, lines 38-56). The Examiner considers the step of comparing data to include validating and verifying the matched and unmatched data before it is compiled to generate an error report. As such, it is respectfully submitted that Edwards is clearly analogous art.

Furthermore, Applicant's argues that the validation process in the claimed invention eliminates "the insertion of erroneous data by enforcing business rules/requirements...hard-coded field checks are met" in the specification, page 24, lines 4-7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that

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the features upon which applicant relies (i.e., “the insertion of erroneous data by enforcing business rules/requirements...hard-coded field checks are met”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(C) In response to Applicant’s argument that, (2) a *prima facie* case of obviousness has not been supported by the examiner because there is no motivation to combine the reference of Buchanan and Edwards and (3) a *prima facie* case of obviousness has not been supported by the Examiner in that all elements of claims 1, 7 and 13 are taught by the disclosed art. The Examiner respectfully submits that establishing a *prima facie* case of obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant’s claimed invention (see: paper number 6).

In addition, the Examiner recognizes obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell*,

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Terry and Davies 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Additionally, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the prior Office Action (paper number 6), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RWM
rwm
June 15, 2003


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
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